

## REMARKS/ARGUMENTS

### **I. Drawing Objections**

The Office objected that relative to claim 35, the deterrent without upwardly extending intermediate prongs in claim 35 is not shown in the drawing. That objection is inappropriate. Claim 35 is silent as to whether there are upwardly extending intermediate prongs, and therefore reads on the figures.

The Office also objected that the round cross-sections must be shown for first and second portions of the intermediate prongs. That objection is also inappropriate. The rule is that claimed elements amenable to a drawing must be shown in at least one figure of the drawing. But there is no claim that recites intermediate prongs having first and second portions with round cross-sections. Thus, there is no requirement to show such (unclaimed) elements in the drawing.

The Office objected to Figure 2 on the grounds that reference characters "22" and "14" are both used to designate the upwardly extending intermediate prongs (22). The applicant does not see the inconsistency. Numeral 14 refers to prongs in general, and numeral 22 refers to specific ones of the prongs having a specific angle. As stated in the specification, numbered page 8, second full paragraph:

The prongs 14 are provided at various angles relative to the underlying surface. As shown best in FIG. 3, prongs 22 are oriented at 90 degrees relative to the underlying surface, prongs 26 and 30 are oriented at about 30 degrees above the underlying surface and prongs 24 and 28 are oriented at about 70 degrees above the underlying surface.

### **II. Claim Objections**

The Office objected that in Claim 29, the language "upwardly prongs" is awkward. The language is changed herein to "intermediate prongs".

### III. 35 USC 112

The Office rejected claims 13-15 as being indefinite because of the word "about." The applicant disagrees. Use of the term "about" is entirely acceptable, and should be according its ordinary meaning of "approximately". See *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1369 (Fed. Cir. 2005) ["We reverse the district court's construction of "about" and hold that such term should be given its ordinary meaning of "approximately.""] See also *In re Harris*, 409 F.3d 1339, 1343 (Fed. Cir. 2005) [Finally, the '326 "Application's use of the term 'about' shows that the applicants did not intend to limit the claimed ranges to their exact end-points"] and *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 1381 (Fed. Cir. 2000) [failure to use term "about" limits numeric statements to the exact number recited].

### IV. 35 USC 102(b)

The Office withdrew all of its anticipation rejections.

### V. 35 USC 103

Claims 10-18 and 2—34 were rejected as being obvious over Richardson (GB 2344269) in view of Shaw (US 3282000). The applicant disagrees with the rejections.

Shaw does suggest five-rayed bird deterrents (see figure 1), but only where the rays (prongs or spikes) are separate pieces from the rail. That requirement obtains from the expectation in the prior art that it was either impossible or impractical to injection mold a unitary deterrent with five rays. Indeed, it was not until the current inventor originated the idea of alternatively high and low lateral spikes that injection molding of five-rayed spikes became possible. The citations to Burnside 2777171 and Peles 2475047 fail to contradict that fact, since both of them use wire spikes rather than plastic, injection molded spikes.

It is true that Richardson describes his invention as an integrally molded deterrent device having at least four different angles relative to the base. But that teaching is not enabled beyond four different angles. Moreover, the four different angles in Richardson comprise a single lateral angle (one off each side) and a single upright angle (one off each side). There is no teaching, suggestion, or motivation for:

(a) pairs of prongs (b) extending laterally from opposite sides of the rail (c) such that successive prongs on each side of the rail alternate between a higher position and a lower position" (independent claim 10); or

(a) the laterally extending prongs on each side of the rail alternate between lower and higher angles relative to the base (independent claim 31); or

(a) laterally extending prongs alternating at various angles (b) of no more than 70 degrees relative to the underlying surface (independent claim 34).

The Office's citation of *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893) is not controlling because it is readily distinguished. In *General Electric Co. v. Dunkirk*, 211 F. 658, 664 (D.N.Y. 1913), for example, the Court distinguished *Howard* on the grounds that *Howard* involved bolting or riveting together sections of a stove in a manner that was known at the time of the alleged invention. In *General Electric*, the specific fastening means was an original adaptation. Similarly, in *Pyle Nat'l Co. v. Lewin*, 92 F.2d 628, 630 (7th Cir. 1937) the Court admonished that *Howard* "must be limited to cases where by such a change no new or different result is attained.

The language of the Court in *Krementz v. S. Conle Co.*, 148 U.S. 556, 559 (U.S. 1893) is far more applicable to our facts. There, the patent "was for an improvement in making a stud fastening known as Thomson's unbreakable busk fastening, and whereby, instead of fastening the parts of the stud together by rivets, the entire busk was made out of one piece of metal, by striking up or raising the stud out of a strip of malleable sheet metal. The structure thus produced is a solid rivet-like and flat head, intended to resist a great strain, and evidently not designed to be used as a collar button where a well-defined round head, adapted to be used where there is no strain, is necessary and essential." (emphasis added).

Our case deals with providing a design that permits manufacture of a five-rayed bird deterrent as a unitary piece of plastic, something that the prior art could never do because they didn't appreciate that the lateral prongs needed to be alternating high and low. In *Richardson*, for example, all of the lateral prongs are at the same height (angle), and not alternating. Even

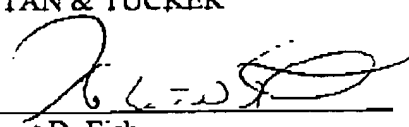
Shaw shows lateral prongs that do not alternate. There is simply no teaching, suggestion, or motivation in the prior art to use lateral prongs of alternating heights.

The rejections as to the dependent claims are all moot. Those claims are all allowable as being dependent upon allowable claims.

**VI. Request For Allowance**

Claims 10-18, and 20-35 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,  
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